

**RESPONSE AFTER FINAL REJECTION
EXPEDITED PROCEDURE - RULE 116**

**Application: 10/664,322
Attorney Ref: 62061.US
Client Ref: EI-7610**

REMARKS

STATUS OF CLAIMS

Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are pending and claims 42 and 43 are added. Claims 1, 12, and 32 have been amended. Support for these amendments to claims 1, 12, and 32 can be found in the originally filed specification, for example on page 14, lines 9-10. Support for new claim 42 can be found in the originally filed specification at page 12, Example 1. Support for new claim 43 can be found in the originally filed specification at page 13, Example 2. No new matter has been added.

REJECTIONS UNDER § 102

US 5,064,546 (Dasai) in view of US 6,660,695 (Watts)

Claims 1-3, 5-6, 9-14, 16-17, 20-21, 32-34, 36-37, and 40-41 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by US 5,064,546 to Dasai ("Dasai") taken in view of the evidence given in US 6,660,695 to Watts ("Watts"). The Examiner has argued that Dasai teaches power transmitting fluid identical to that presently claimed including an additive composition identical to that presently claimed, the power transmitting fluid would inherently possess enhanced wear protection and enhanced anti-shudder durability. Applicants respectfully disagree for at least the following reasons.

The presently amended independent claims 1, 12, and 32 comprise an anti-foam agent, wherein the anti-foam agent comprises about 0.01 to about 0.08 wt.% of the power transmitting fluid. Nothing in Dasai teaches, points to, or discloses the use of an anti-foam agent utilized in such an amount. Therefore, Dasai does not anticipate the presently claimed invention. For at least this reason, the presently claimed invention possesses novelty over the reference. Applicants respectfully request reconsideration and withdrawal of the rejection.

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Further new claims 42 and 43 are novel over Dasai since Dasai teaches nothing about methods for improving wear or anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

REJECTIONS UNDER § 103(a)

US 5,064,546 (Dasai)

Claims 22-24, 26-27, and 30-31 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dasai.

Presently presented claim 22 is directed to a power transmitting fluid additive composition comprising a dispersant, an antioxidant, an anti-foam agent, and a dioleoyl hydrogen phosphate. Nothing in Dasai discloses, teaches, or suggests such an additive composition. In particular, Dasai teaches the combination of a base oil with various components including a defoaming agent to prepare a Basic Oil. To the Basic Oil is added other various components. See the Examples in Dasai. None of the components of Dasai are combined in such a way to provide an additive composition as claimed in claim 22. Thus, claim 22 and its dependent claims are not made obvious by the disclosure of Dasai. For at least this reason, the presently claimed invention is nonobvious over the reference. Applicants respectfully request reconsideration and withdrawal of the rejection.

Further new claims 42 and 43 are nonobvious over Dasai since Dasai teaches nothing about methods for improving wear or anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

US 6,528,458 (Tagliamonte)

Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over US 6,528,458 to Tagliamonte ("Tagliamonte").

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Tagliamonte discloses a formulation for lubricating a dual clutch transmission that comprises a base oil, DMTD, a friction modifier other than DMTD, and a dispersant other than DMTD. Nothing in Tagliamonte points to, suggests, or makes obvious a choice of the particular components as presently claimed to provide improved wear and/or anti-shudder durability. Further, Tagliamonte does not disclose an additive composition as defined in claim 22. To make the presently claimed combinations by reading Tagliamonte requires impermissible hindsight. For at least these reasons, the presently claimed invention is nonobvious over the reference. Applicants respectfully request reconsideration and withdrawal of the rejection.

Further new claims 42 and 43 are nonobvious over Tagliamonte since Tagliamonte teaches nothing about methods for improving wear or anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

US 4,231,757 (Davis) in view of US 6,528,458 (Tagliamonte) and US 6,660,695 (Watts)

Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over US 4,231,757 to Davis ("Davis") in view of Tagliamonte and Watts.

Davis discloses nitrogen-containing compositions made by condensing a nitro phenol with an organic amino compound having at least one hydrogen atom directly bonded to a nitrogen or oxygen atom that are useful in lubricants and fuels. Davis requires the combination of at least one nitro phenol of a particular formula and at least one amino compound having at least one hydrogen atom directly bonded to a nitrogen atom or to an oxygen atom. The Examiner has pointed to Example A of column 22 in Davis as disclosing a dispersant, an antioxidant, a dialkyl hydrogen phosphite, and an anti-foaming agent. The Examiner then combines the reference with Tagliamonte for a selection of dioleoyl hydrogen phosphite; however, there is no reason for one of ordinary skill in the art to select dioleoyl hydrogen phosphite as the dialkyl hydrogen phosphite. Davis teaches nothing about utilizing the presently claimed combinations or utilizing them to improve wear or anti-shudder durability. There is no apparent reason to make the claimed combinations by reading Davis in view of Tagliamonte and

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Watts other than upon impermissible hindsight after reading the applicants' present patent application. For at least these reasons, the presently claimed invention is nonobvious over this combination of references. Applicants respectfully request reconsideration and withdrawal of the rejection.

Further new claims 42 and 43 are nonobvious over Davis in view of Tagliamonte and Watts since the combination of these references teaches nothing about methods for improving wear or anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

US 2004/0129603 (Fyfe) in view of US 6,884,855 (Nelson) and US 6,660,695 (Watts)

Claims 1-3, 5-6, 9-14, 16-17, 20-24, 26-27, 30-34, 36-37, and 40-41 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over US 2004/0129603 to Fyfe ("Fyfe") in view of US 6,884,855 to Nelson ("Nelson") and Watts.

Fyfe discloses base oils having an unexpected combination of high viscosity index and a ration of measured-to-theoretical high-shear/low-temperature viscosity at -30C or lower and methods of making them. The disclosure states that this base oil can be used with various combinations of performance additives. However, nothing in Fyfe points to the presently claimed combination of components nor to improvements in wear and anti-shudder achieved by their particular combination, as claimed herein. The Examiner refers to Nelson for its disclosure of diolel hydrogen phosphite. However, there is no motivation apparent from these references for a substitution of diolel hydrogen phosphite for dibutyl hydrogen phosphite. The Examiner incorrectly states that Nelson discloses the "equivalence and interchangeability of using dibutyl hydrogen phosphite...with diolel hydrogen phosphite." No such statement is found in Nelson. Nelson merely discloses a very long list of phosphorus-containing components, wherein those two components happen to be members of that very long list. The Examiner has merely selected two phosphorus-containing components from the list and opined that they are interchangeable. See Column 11 of Nelson for the full list. There exists no apparent reason to make the claimed combinations by reading Fyfe in view of Nelson and Watts other than upon impermissible

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hindsight after reading the applicants' present patent application. For at least these reasons, the presently claimed invention is nonobvious over this combination of references. Applicants respectfully request reconsideration and withdrawal of the rejection.

Further new claims 42 and 43 are nonobvious over Fyfe in view of Nelson and Watts since the combination of these references teaches nothing about methods for improving wear or anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

US 2005/0014656 (Sumiejski) in view of US 5,064,546 (Dasai) and US 6,660,695 (Watts)

Claims 20-23, 25-27, and 30-31 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over US 2005/0014656 to Sumiejski ("Sumiejski") in view of Dasai and Watts.

Nothing in Sumiejski points to the presently claimed combination of components nor to improvements in wear and anti-shudder achieved by their particular combination, as claimed herein. The Examiner refers to Dasai for its disclosure of diolel hydrogen phosphite. However, there is no motivation apparent from these references for a substitution of diolel hydrogen phosphite for the hydrocarbyl phosphite of Sumiejski. The Examiner incorrectly states that Dasai discloses the "equivalence and interchangeability of using dilauryl hydrogen phosphite...with diolel hydrogen phosphite." No such statement is found in Dasai. Dasai merely discloses a list of phosphorus-containing components, wherein those two components happen to be members of that list. The Examiner has merely selected two phosphorus-containing components from the list and opined that they are interchangeable. See Column 4 of Dasai for the full list. There exists no apparent reason to make the claimed combinations by reading Sumiejski in view of Dasai and Watts other than upon impermissible hindsight after reading the applicants' present patent application. For at least these reasons, the presently claimed invention is nonobvious over this combination of references. Applicants respectfully request reconsideration and withdrawal of the rejection.

Further new claims 42 and 43 are nonobvious over Sumiejski in view of Dasai and Watts since the combination of these references teaches nothing about methods for improving wear or

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anti-shudder durability of a power transmitting fluid utilizing the combination of components of the present claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

FEES

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, PC

By: 

Leah Oubre Robinson, Reg. No. 44,990

September 19, 2006
P.O. Box 1871
Knoxville, TN 37901
865.546.4305 (telephone)
865.934.5079 (direct)
865.523.4478 (fax)
LRobinson@lng-patent.com